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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,288	06/13/2000	Bernd Stein	860098.403C1	7248

7590

06/04/2002

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EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/04/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,288

Applicant(s)

STEIN ET AL.

Examiner

Yong Pak

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 22 is/are allowed.
- 6) ☒ Claim(s) 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed on March 21, 2002, has been entered. This application is a continuation of 08/576,240, now issued as U.S. Patent No. 6,074,862.

Claims 1 and 22-26 are pending.

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action. Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

Response to Amendment

The declaration filed on March 21, 2002 under 37 CFR 1.131 is sufficient to overcome the 102(e) reference.

Response to Arguments

Applicant's arguments filed March 21, 2002 have been fully considered but they are not persuasive.

Drawings

The sequences in Figure 1 should be identified by SEQ ID numbers and must comply with the Sequence Rules, see 37 CFR 1.821-1.825.

Claim Rejections - 35 USC § 112

Claims 23-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants argue that the specification provides a representative number of species of the genus. The examiner disagrees. The claims are drawn to polypeptides having no limitations to the function of the polypeptides. Therefore, this claim is drawn to a large variable genus of mitogen-activated protein kinase kinase (MEK6) activity, unknown activity, or inactive variants. The specification does not describe the function of all the polypeptide derived or modified from SEQ ID NO:2 as encompassed in the claims.

Claims 23-26 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the MEK6 of SEQ ID NO:2, does not reasonably provide enablement for a MEK6 with structures different from SEQ ID NO:2. The specification does not reasonably provide enablement for a polypeptide of unknown function. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants argue that one skilled in the art could make and use the claimed invention without undue experimentation. The examiner disagrees.

The claimed invention is drawn to polypeptides of unknown function. The function of a polypeptide can not be determined from its structure and the specification does not teach how to use polypeptides with unknown function. Further, claim 25 is drawn to variant polypeptides of SEQ ID NO:2 having "constitutively active" polypeptides. The specification does not teach how to use variant polypeptides of SEQ ID NO:2 having any activity. Therefore, the breadth of these claims is much larger than the scope enable by the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Claims 25-26 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants argue that the scope of the claims is clear because the specification provides a definition of each phrase. The examiner disagrees. Although page 6, lines 31-34 and page 7, lines 3-4 of the specification contain some definitions of the phrases, the definitions are not a definite definition but offer examples or preferred meanings. The claims are unclear because the claim can refer to many polypeptides with different activities. Therefore, the scope of the polypeptides in claims 25-26 is unclear.

Double Patenting

Claims 23-26 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S.

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Patent No. 6,074,862. Applicants have requested that this rejection be held in abeyance until an allowable subject matter is indicated.

Claims 1 and 22 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner

May 31, 2002


CHARLES L. PATTERSON, JR.
PRIMARY EXAMINER
GROUP 1800